



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/687,123  | 10/16/2003  | Paul A. Warfel       | 34555US1            | 7346             |
| 116   | 7590        | 03/12/2004           | EXAMINER            |                  |
| PEARNE & GORDON LLP<br>1801 EAST 9TH STREET<br>SUITE 1200<br>CLEVELAND, OH 44114-3108 |             |                      | CHIESA, RICHARD L   |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 1724                |                  |

DATE MAILED: 03/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                               |  |
|------------------------------|-------------------------------|-------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/687,123 | Applicant(s)<br>WARFEL ET AL. |  |
|                              | Examiner<br>Richard L. Chiesa | Art Unit<br>1724              |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 October 2003 and 12 February 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 14 is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☒ Claim(s) 13 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. The preliminary amendments filed on October 16, 2003 and February 12, 2004 have been entered.

### ***Drawings***

2. The drawings filed on October 16, 2003 are accepted as formal drawings by the examiner.

### ***Specification***

3. The disclosure is objected to because of the following informalities: (A) The specification fails to indicate that the cited parent application is now U.S. Patent No. 6,691,988. (B) The word "phase" at the beginning of line 15 on page 13 should be changed to --phrase--. Appropriate correction is required.

### ***Claim Objections***

4. Claim 13 is objected to because the word --a-- should apparently be inserted between "to" and "projecting" in the second line of clause b. Appropriate correction is required.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or

Art Unit: 1724

improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 1-12 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of applicants' prior U.S. Patent No. 6,691,988. Although the conflicting claims are not identical, they are not patentably distinct from each other because the omission of a smooth top surface on the adjustment screw head would have been a readily obvious expedient since most screws have various features on the top surface usually intended for engagement with a tool.

7. Claims 1-12 are also rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-12 of applicants' U.S. Patent No. 6,691,988 in view of Shaw et al. The only difference between applicants' patented adjustment screw arrangement and the presently claimed adjustment screw arrangement is that the presently claimed screw does not necessarily have a smooth top surface. In any case, Shaw et al (note ref. num. 10, 110, Figs. 1, 8, 9, 12, and col. 4, lines 65-67) teach the well-known use of a screw top surface having a slot in an adjustment screw arrangement for the purpose of facilitating tool engagement. Consequently, it would have been readily obvious to one having ordinary skill in

Art Unit: 1724

the art to employ slots on the screw top surface in applicants' patented adjustment screw arrangement in order to facilitate tool engagement as taught by Shaw et al.

***Allowable Subject Matter***

8. Claim 14 is allowed.
9. Claim 13 would be allowable if the correction noted above in paragraph 4 is made.
10. Claims 1-12 would be allowable upon the filing of a proper terminal disclaimer as explained above in paragraph 5.
11. As allowable subject matter has been indicated, applicants' reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicants' disclosure. These references have been cited as art of interest to show other carburetors and adjustment screw assemblies.
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Chiesa whose telephone number is (571) 272-1154.

Art Unit: 1724

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine R. Copenheaver, can be reached at (571) 272-1156.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1700 receptionist whose telephone number is (571) 272-0987.

Facsimile correspondence must be transmitted through (703) 872-9306.

Richard L. Chiesa

March 4, 2004

*Richard L. Chiesa*

**RICHARD L. CHIESA  
PRIMARY EXAMINER  
ART UNIT 1724**

*March 4, 2004*